

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1, 5, 6 and 11 are rejected under 35 USC 102(b) as being anticipated by the U.S. patent to Jameson et al.

Claims 1, 3, 4, 7, 8 and 10 are rejected under 35 USC 103(a) as being unpatentable over the U.S. patent to Jameson et al.

Claim 2 is rejected under 35 USC 103(a) over the U.S. patent to Jameson et al in view of the U.S. patent to Burek et al.

Also, the drawings are objected to.

At the same time Claim 9 was indicated as allowable by the Examiner.

In connection with the Examiner's objection to the drawings, applicants submitted herewith a copy of the drawings with the proposed correction identifying the recess (5). It is believed that the Examiner's grounds for the objection to the drawings should be considered as no longer tenable and should be withdrawn.

The Examiner's indication of the allowability of Claim 9 has been gratefully acknowledged. In connection with this indication Claim 9 has been amended by introducing into it the features of Claim 1 and making it independent. The thusly amended Claim 9 should be allowed.

After carefully considering the Examiner's grounds for rejection of the claims over the art, applicants amended Claim 1, the broadest claim on file, so as to more clearly define the present invention and to distinguish it from the prior art.

Claim 1 as amended, in addition to other features now defines that the covering cap (3) has a cutout, into which the sheet (2, 2.1) is inserted, and the covering cap (3) is transparent.

Claim 11, the broadest claim on file defining an installation set with a fire alarm, has been amended correspondingly. The additional feature, wherein the covering cap has a cutout, into which the sheet is inserted, is disclosed in the specification, and in particular in lines 20-22 of page 2 of the specification. The additional feature that the covering cap is transparent is introduced into Claim 1 from Claim 2.

Turning now to the prior art applied by the Examiner, and in particular to the patent to Jameson, it can be seen that this reference

which deals with a smog detector with a masking shield, does not disclose that the sheet is located between the covering cap, it does not disclose that the covering cap has a cutout, and finally, it also does not disclose that the covering cap is transparent.

The patent to Jameson disclose to adhere the sheet to the shield, as shown in Figure 7, and described in column 4, lines 45-55. Therefore it is not obvious to use a covering cap with a cutout and to locate the sheet between the covering cap and the insert.

The Examiner rejected the original claims over the patent to Jameson as being anticipated. As explained hereinabove, the patent to Jameson does not disclose the new features of the present invention as now defined in Claims 1 and 11. It is believed to be advisable, in connection with this, to cite the decision In Re: Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Jameson does not disclose each and every element of the fire alarm in accordance with the present invention

and the installation set with a fire alarm in accordance with the present invention as defined in Claims 1 and 11. Therefore, the anticipation rejection should be considered as not tenable with respect to amended Claims 1 and 11 and should be withdrawn.

As for the Examiner's rejection of the claims over the patent to Jameson as obvious, it is respectfully submitted that not only the patent to Jameson does not disclose the above mentioned new features of the present invention, but also it does not provide any hint, suggestion or motivation for such features. A person of ordinary skill in the art would not arrive at the present invention from the teaching of the patent to Jameson, but instead he would have to fundamentally modify the construction disclosed as the reference, and in particular by including into it the new features of the present invention which are now defined in amended Claims 1 and 11. However, it is known that in order to arrive at a claimed invention by modifying the references, the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper

use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the new features of the present invention cannot be derived from the reference as a matter of obviousness.

In view of the above presented remarks and amendments, it is believed that Claims 1 and 11 should be considered as patentably distinguishing over the art and should be allowed.

The U.S. patent to Burek applied by the Examiner also does not teach the new features of the present invention as defined in amended Claims 1 and 17, and therefore any detailed comments thereon would be superfluous.

As for the dependent claims, these claims depend on Claim 1, they share its allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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